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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/081,347 | 02/21/2002 | Theresa A. Deisher | 96-20C5 | 2963 |

7590 03/23/2004

Deborah A. Sawislak
Patent Department, ZymoGenetics, Inc.
1201 Eastlake Avenue East
Seattle, WA 98102

EXAMINER

SAOUD, CHRISTINE J

ART UNIT PAPER NUMBER

1647

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,347

Applicant(s)

DEISHER ET AL.

Examiner

Christine J. Saoud

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1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 19-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Sequence alignment

DETAILED ACTION

Election/Restrictions

Claims 19-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed 04 March 2004.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). ***The specific reference to any prior nonprovisional application must include the relationship*** (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Additionally, the status of the U.S. Application referenced should be updated (i.e. abandoned, patented, etc.).

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate

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paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

At the time of the instant Office action, no IDS is of record in the instant application.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See at least pages 17-18 and 66-67. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No.

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5,989,866. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '866 anticipate the claims of the instant application. Therefore, allowance of the instant claims would provide an unjustified or improper timewise extension of the "right to exclude" granted by a patent for the subject matter of '866.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 4, 7, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by GREENE et al. (U.S. Pat. No. 6,013,477).

Greene et al. disclose a protein with an amino acid sequence (SEQ ID NO:16) which has at least 60% amino acid sequence identity with SEQ ID NO:2 in the regions

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recited by the claims. (See exemplary sequence alignment, attached). Therefore, Greene et al. anticipate the instant claims.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine J. Saoud whose telephone number is 571-272-0891. The examiner can normally be reached on mttr, 8:00-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHRISTINE J. SAOUD
PRIMARY EXAMINER

Christine J. Saoud

Sequence Alignment -- Attachment --

GenCore version 5.1.6
Copyright (c) 1993 - 2004 Compugen Ltd.

OM protein - protein search, using sw model

Run on: March 19, 2004, 12:47:49 ; Search time 0.001 Seconds
(without alignments)
31.820 Million cell updates/sec

Title: us-10-081-347-2
Perfect score: 777
Sequence: 1 EENVDFRIHVENQTRADDV.....KGRPRKGPXTRENQDDVHFM 148

Scoring table: BLOSUM62
Gapop 10.0 , Gapext 0.5

Searched: 1 seqs, 215 residues

Total number of hits satisfying chosen parameters: 1

Minimum DB seq length: 0
Maximum DB seq length: 2000000000

Post-processing: Minimum Match 0%
Maximum Match 100%
Listing first 1 summaries

Database : us-09-103-079-16.*

Pred. No. is the number of results predicted by chance to have a score greater than or equal to the score of the result being printed, and is derived by analysis of the total score distribution.

SUMMARIES

| Result No. | Score | Query Match | Length | DB ID | Description |
|------------|-------|-------------|--------|-------|------------------|
| 1 | 504.5 | 64.9 | 215 | 1 | us-09-103-079-16 |

ALIGNMENTS

RESULT 1
us-09-103-079-16

| | | | | |
|-----------------------|-------|---|-------|----------------------------------|
| Query Match | 64.9% | Score 504.5; | DB 1; | Length 215; |
| Best Local Similarity | 61.1% | Pred No. 0; | | |
| Matches | 91; | Conservative | 28; | Mismatches 29; Indels 1; Gaps 1; |
| QY | 28 | EENVDFRIHVENQTRADDVSRKQLRLYLQYLSRTSGKHQVL-GREISARGEDGDYQQL 86 | | |
| Db | 27 | QSSPFTQHVREQLSLTDQLSRLIRTYQLYLSRTSGKHQVLANKRNAMAEEDGDPFACL 86 | | |
| QY | 87 | LVEITDTPGSOVRIRKGETEYELCNKPKGLVKGPDGTSKECVFEIKVLENNYALMSAKY 146 | | |
| Db | 87 | IVETDTPGSRVRVARGAETGLYICNKKGLIAKSNKGKDCVFEIVLENNYALQNAKY 146 | | |
| QY | 147 | SGWYVGFKKGRPKRPTRENQDDVHFM 175 | | |
| Db | 147 | EGWYMAFTRKGRPKRPTRENQDDVHFM 175 | | |

Search completed: March 19, 2004, 12:47:49
Job time : 0.001 secs